

Title: GOLF CLUB WITH SWING BALANCE WEIGHT COVER  
Serial No. 10/706,481  
**Response**

### REMARKS

Claims 1-19 were pending in the application. Claims 17-20 are cancelled by this amendment. New claim 21 is added by this amendment. Accordingly, claims 1-16 and 21 are now pending in the application.

Claims 1-15, 11, 12, and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious considering U.S. Patent No. 6,811,496 to Wahl et al. Claims 1 and 15 have been amended to overcome the rejection. Wahl et al. discloses a vibration damping apparatus for use in a golf club head comprising a plurality of weighted core elements and an elastomeric intermediate layer. The weighted core members are not used to swing balance weight the club. Accordingly as an initial matter, nothing in Wahl et al. discloses or suggests providing a plurality of *balance* weights, or selecting and attaching one of said plurality of *balance* weights as disclosed in the application and claimed in claims 1 and 15.

Additionally, since the vibration damping apparatus of Wahl et al. relies on relative movement between the weighted core elements and the elastomeric intermediate layer to perform its essential function of dissipating vibrational energy, it is critical that the weighted core elements [reference 42 in Fig. 5B of Wahl et al.] be permitted to move relative to the club head. See, e.g. Col. 2, lines 54-62 which states:

An insert is located within the recess and includes a core and an intermediate layer that at least partially separates the core from the recess wall. The intermediate layer has a hardness and a modulus of elasticity that are less than that of the core, such that when the golf club head is used to strike a golf ball, the resulting vibrations are dissipated by compression of the intermediate layer and friction between the core and the intermediate layer.

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Since it is critical that the weighted core elements of the vibration damper of Wahl et al. be permitted to move relative to the club head, modification of the golf club disclosed in Wahl et al. to include weights that are *rigidly* attached to the club head, as claimed in claims 1 and 15 as amended, would render Wahl et al. unsatisfactory for its intended purpose.

It is well-settled that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification and a rejection based on such a proposed combination is improper. MPEP 2143.01; In Re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, applicants urge that claims 1 and 15 as amended, and the claims that depend on claims 1 and 15 are allowable over the art of record.

Claims 7-10, and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious considering U.S. Patent No. 6,811,496 to Wahl et al. in view of U.S. Patent No. 6,162,133 to Peterson. For the reasons discussed above, however, since *any* proposed modification of Wahl et al. to include weights that are *rigidly* attached to the club head would render Wahl et al. unsatisfactory for its intended purpose, any rejection based on such a proposed combination is improper under § 103. Accordingly, for this reason alone, claims 7-10 and 13 are allowable over the cited references. Additionally, however, Peterson merely discloses a hollow body golf club head with an opening in the side skirt that leads to the interior of golf club and a cover that snaps in place over the opening. Nothing in Peterson teaches or suggests use of such a cover for covering a solid insert such as a swing weight.

It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive in the prior

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art supporting the combination. In Re Geiger, 815 F.2d, 686, 688 (Fed. Cir. 1987); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). Use of the inventor's own disclosure as a blueprint for piecing together the prior art to defeat patentability is the essence of impermissible hindsight reconstruction. In Re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Accordingly, absent some teaching in Peterson or Wahl et al. suggesting a cover for a balance weight having the tab and slot configuration disclosed and claimed in claims 7-10 and 13, the rejection of these claims under § 103 is improper and should be withdrawn for this additional reason.

Claims 6-10, and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious considering U.S. Patent No. 6,811,496 to Wahl et al. in view of U.S. Patent No. 6,015,354 to Ahu et al. For the reasons discussed above *any* proposed modification of Wahl et al. to include weights that are *rigidly* attached to the club head, (including by the use of screws as suggested by the Examiner) would render Wahl et al. unsatisfactory for its intended purpose. Accordingly, any rejection based on such a proposed combination is improper under § 103. Therefore, for this reason alone, claims 6-10 and 13 are allowable over the cited references.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being obvious considering U.S. Patent No. 6,811,496 to Wahl et al. in view of U.S. Patent No. 6,409,612 to Evans et al. For the reasons discussed above, however, *any* proposed modification of Wahl et al. to include weights that are *rigidly* attached to the club head would render Wahl et al. unsatisfactory for its intended purpose. Accordingly, any rejection based on such a proposed combination is improper under § 103. Therefore, for this reason alone claim 14 is allowable over the cited references. Additionally, however, Evans does not disclose a monogrammed weight cover that covers a

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weight attached to the club head body. Instead, in Evans the weighting device [reference 20 in Evans] is itself monogrammed. Therefore, to use the weighting device disclosed in Evans on two different models of clubs (where different monograms are required as opposed to simply the manufacturer's name), two different weighting devices would be required, which is exactly the problem sought to be solved by the present invention. Accordingly, for this additional reason, claim 14 is allowable over the cited references.

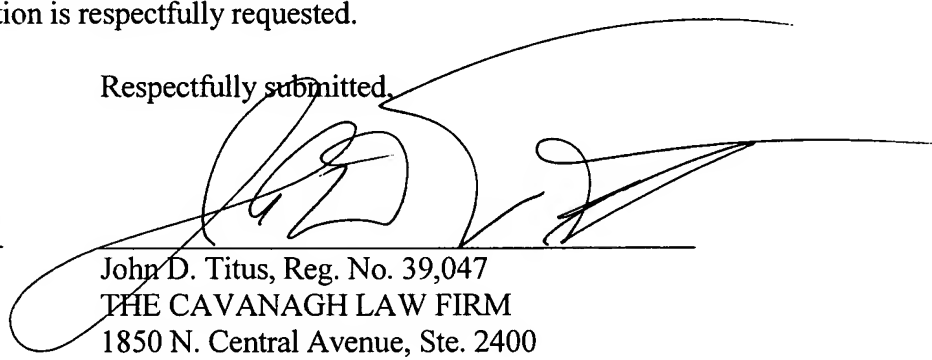
New claim 21 is added to further claim the invention disclosed in the present application. Claim 21 is directed to a method of manufacturing a plurality of different model clubs each of which have different weight cavity covers but share common weight cavity dimensions and therefore can share a common plurality of swing weight members.

Conclusion

No new matter is introduced by the amendments herein. Based on the foregoing, applicants believe that all claims under consideration are in a condition for allowance and reconsideration of this application is respectfully requested.

Respectfully submitted,

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